

### **REMARKS/ARGUMENTS**

The Office Action of July 12, 2004 has been considered and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested.

Claims 12-36 are pending in this application. By this amendment, claims 12-36 have been amended to clarify subject matter Applicants regard as the invention and to clarify functional relationships between the recited user interface displays or the recited steps, and the corresponding structure. The subject matter of the claim amendments is supported by the specification and drawings as originally filed.

Claims 12-36 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-39 of U.S. Patent No. 5,924,082, which has common ownership with the present application. Applicants submit herewith a terminal disclaimer signed by a registered attorney of record. Accordingly, Applicants respectfully request that these rejections be reconsidered and withdrawn.

Claims 12-36 stand rejected as allegedly being unpatentable under 35 U.S.C. § 103(a) over one of the following references: U.S. Patent Nos. 5,077,665 and 5,136,501 to Silverman et al. (respectively Silverman '665 and Silverman '501); U.S. Patent No. 4,677,552 to Sibley, Jr. (Sibley); U.S. Patent Nos. 4,980,826 and 4,903,201 to Wagner (respectively Wagner '826 and Wagner '201); U.S. Patent No. 5,168,446 to Wiseman (Wiseman). Claims 12-36 further stand rejected as allegedly being unpatentable under 35 U.S.C. § 103(a) over one of the above-listed references or U.S. Patent No. 4,799,156 to Shavit et al. (Shavit) in view of either U.S. Patent No. 5,267,148 to Kosaka et al. (Kosaka); U.S. Patent No. 5,297,031 to Gutterman et al. (Gutterman); or U.S. Patent No. 5,297,032 to Trojan et al. (Trojan). Applicants respectfully traverse these rejections.

The Office Action correctly states that the prior art of record does not disclose each of the recited display regions or steps of claims 12-36. The Office Action further submits that the differences with the prior art "are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited." Applicants respectfully submit that claims 12-36, as amended, recite the subject matter of displaying display regions that are functionally related to the user terminal, which is not taught or suggested by the prior art of

record. In addition, Applicants respectfully submit that the claimed subject matter of receiving a notification and of communicating a negotiation are not taught or suggested by the prior art of record.

The present invention pertains to a user terminal of a negotiating matching system, which identifies potential parties to a potential transaction based on one or more fixed trading parameters, such as bid, offer, credit or ranking data. Instead of automatically executing the identified potential transaction, "the system introduces compatible counterparties who are provided with an opportunity to communicate with one another prior to execution of the transaction to negotiate some or all terms of the transaction." Specification, page 23, lines 22-24.

Accordingly, independent claim 12 recites *inter alia* a first user terminal performing the steps of "receiving from said matching computer a notification of a potential match between said first non-negotiable values and second non-negotiable values from said second user, said potential match including a first potential counterparty for a potential transaction, said notification including identification of said first potential counterparty" and of "communicating a negotiation of said first and second negotiable values with a second user terminal associated with the second user." Independent claim 29 recites a method comprising similar subject matter. This subject matter and the subject matter of the novel displays of negotiable and non-negotiable information that are functionally related to the user terminal are not taught or suggested by the prior art of record.

In contrast, Silverman '665 and '501 disclose automatic matching systems in which bids and offers are matched and executed as a transaction. However, neither Silverman '665 nor '501 disclose or suggest at least receiving a notification of a potential match, communicating a negotiation, displaying negotiable and non-negotiable information. Further, there is not a need for the systems of Silverman '665 and '501 to receive or display negotiable information to fulfill the purposes of the system.

Sibley discloses an International Commodity Trade Exchange that has a central exchange 14 in communication with local exchanges 11 (see Figs. 1 and 2). User computer terminals are coupled to the local exchanges and can thereby receive market data from the central exchange

via their local exchange, which can include bid and offer information. (Abstract). However, users of this system identify potential transactions via communication with a potential counterparty they select themselves. "Thus, the system allows any one local user terminal 12 associated with any one particular local commodity exchange 10 to communicate with and trade, if desired, with any other user terminal 12 associated with any other of the local commodity exchanges 10 ... ." Col. 5, lines 21-25. The system of Sibley merely provides information to users without identifying potential transactions and counterparties, or communicating negotiable values. Further, there is not a need for the system of Sibley to identify potential transactions or counterparties, or to communicate or display negotiable values to fulfill the purposes of the system.

Wagner '826 and '201 disclose automated trading systems in which bids and offers for a commodity are compared, matched, and automatically executed as a transaction if the transaction falls within predetermined constraints. (*See e.g.*, Wagner '201, col. 5, lines 10-15 and lines 39-61). However, neither Wagner '826 nor '201 disclose or suggest at least receiving an identification of potential counterparties to a transaction, communicating a negotiation for a potential transaction, or displaying negotiable and non-negotiable information. Further, there is not a need for the systems of Wagner '826 and '201 to communicate or display negotiable values to fulfill the purposes of the system.

Wiseman discloses a system for processing spot trades through a series of structured stages, which include a first trading station sending a request for quote to a second trading station, a quote from the second to the first trading station, and acceptance from the first trading station to the second. (*See e.g.*, Fig. 5). However, Wiseman fails to disclose or suggest at least receiving an identification of potential counterparties to a transaction, communicating a negotiation for a potential transaction, or displaying negotiable and non-negotiable information. Further, there is not a need for the system of Wiseman to identify potential transactions or counterparties, or to communicate or display negotiable values to fulfill the purposes of the system.

Shavit discloses an interactive electronic communication system that permits users to view user information in a database, and allows business transaction sessions between users.

(Abstract). "The system 50 permits users such as buyers, sellers, etc. at remote sites to conduct business transactions and communicate with data bases on other computer services from a variety of remote terminals, as shown." Col. 5, lines 20-24. However, Shavit fails to disclose or suggest at least receiving an identification of potential counterparties to a transaction, communicating a negotiation for a potential transaction, or displaying negotiable and non-negotiable information. Further, there is not a need for the system of Shavit to identify potential transactions or counterparties, or to communicate or display negotiable values to fulfill the purposes of the system.

Kosaka and Trojan were relied upon in the Office Action for their teachings of information displays. However, neither Kosaka nor Trojan overcomes the deficiencies of the primary references discussed above. In addition, there is no motivation to modify the user terminals disclosed in the primary references with the either Kosaka or Trojan to provide the claimed invention. If any of the primary references were nonetheless combined with either Kosaka or Trojan, the improper combination would not provide the recited user terminal or method of displaying negotiable and non-negotiable values. The Office Action indicates that Gutterman is provided as a secondary reference for rejecting claims 12-36, but does not provide a justification or discussion for rejecting these claims over Gutterman. Applicants respectfully requests that the Examiner provide a basis for applying Gutterman as a reference if any rejections are to be maintained over Gutterman.

Neither Sibley, Shavit, Wagner '826, Wagner '201, Silverman '665, Silverman '501 nor Wiseman, either alone in combination with Kosaka or Trojan, disclose or suggests the present invention according to independent claims 12 or 29. Accordingly, Applicants respectfully submit that these claims are patentable over the prior art of record. Further, Applicants respectfully submit that claims 13-28 and 30-36 are allowable, at least because they each ultimately depend from one of claims 12 and 29, and further in view of the novel features recited therein.

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance,

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the Examiner is respectfully urged to contact Applicant's undersigned representative at the below-listed number.

Respectfully submitted,

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Dated: October 12, 2004

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